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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/735,394 | 12/12/2003 | Peter Euteneuer | LWEP:121US | 1710 |

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EXAMINER

PRITCHETT, JOSHUA L

ART UNIT PAPER NUMBER

2872

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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| | | | |
|------------------------------|--|---|--|
| Office Action Summary | Application No. 10/735,394 | Applicant(s) EUTENEUER ET AL. | |
| | Examiner Joshua L. Pritchett | Art Unit 2872 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to Preliminary Amendment filed December 13, 2002. Claims 3-6 have been amended and claims 8-48 have been added as requested by the applicant.

Claim Objections

Claims 4 and 9-11 are objected to because of the following informalities: the claims refer to "the optical element" there is no previous mention of "a optical element." Based on the reference numerals provided in the claims the examiner assumes that the applicant means "the optical deflection element." Still there is no previous mention of an "optical deflection element" in any claim but claim 3. The examiner suggests changing "the optical element" to "the optical deflection element" and changing the claims to properly depend from a claim that includes the limitation of an "optical deflection element." The claims will be examined as if they read "the optical deflection element" and properly depended from a claim that previously mentioned an "optical deflection element." Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 and 8-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Takahama (US 2002/0131165).

Regarding claim 1, Takahama discloses an inverted microscope having a U-shaped microscope housing (1) on one limb whereof is provided a horizontal changing surface (51; which has edges that move in the horizontal direction) for optomechanical adaptation of a module (Fig. 8), wherein the module (54 and 201) comprising a horizontally protruding base (Fig. 8) having on the one hand a binocular tube (64) placed thereon and on the other hand a photo tube (201) with a photo device (202) placed thereon (Fig. 8).

Regarding claim 2, Takahama discloses the module is embodied as a one-piece combination module (Fig. 8) and has on its underside a module changing apparatus (53) that corresponds to the horizontal changing apparatus (Fig. 8). Takahama shows that the horizontal changing apparatus moves (from Fig. 7 to Fig. 8) such that the module changing apparatus must be inserted when the Takahama invention is in the state as shown in Fig. 8 but removed when the invention is in the state shown in Fig. 7.

Regarding claims 3 and 8, Takahama disclose the vertical optical axis (coming off deflector 55) of the observation beam bundle, extending in the one limb penetrates through a first optical deflection element (56) after entering the base unit (Fig. 8) then passes through first tube lens (63) arranged in the binocular tube, while the photo beam deflected at the optical deflection

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element (Fig. 8), after passage through a second tube lens (204) and after deflection by a second optical deflection element (206) enters the phototube with attached photo device (Fig. 8).

Regarding claims 4 and 9-11, Takahama discloses the optical deflection element can be selectably brought into or out of the working position (Figs. 7 and 8). Fig. 7 shows that there is no element 56, while Fig. 8 shows an element 56 to operate as the optical deflection element.

Regarding claims 5 and 12-18, Takahama discloses an infinity beam exists in the region of the changing surface of the module changing apparatus (Fig. 8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7 and 19-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahama (US 2002/0131165).

Takahama teaches the invention as claimed but lacks reference to different corrections for the photo tube and the binocular tube. It is extremely well known in the art to use periplan correction for flat field eyepieces and HC correction for magnetic recording media. Official Notice is taken. It would have been obvious to one of ordinary skill in the art at the time the

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invention was made to have the Takahama invention include the corrections as known in the art for the purpose of producing a clear image to both the viewer and the photo device.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L. Pritchett whose telephone number is 571-272-2318. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLP 



DREW A. DUNN
SUPERVISORY PATENT EXAMINER